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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

*Ex parte* CLIFTON W. LANEY, ROBERT A. DUNSTAN, and
DAN NOWLIN

_____

Appeal 2009-005079
Application 10/643,421
Technology Center 2100

_____

Before JEAN R. HOMERE, ST. JOHN COURTENAY III, and
THU A. DANG, *Administrative Patent Judges.*

COURTENAY, *Administrative Patent Judge*

DECISION ON APPEAL[1]

_____

[1] The two-month time period for filing an appeal or commencing a civil
action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing,
as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE"
(paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery
mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 from the
Examiner's final decision rejecting claims 1-16 and 19-26. Claims 17 and
18 have been cancelled. We have jurisdiction over the appeal under 35
U.S.C. § 6(b).

We Affirm.


Claim 1 is illustrative:

> 1.    A method, comprising:
>
>     determining that a display unit has transitioned from a
> higher power state to a power off state; and
>
>     arranging for an opaque graphical user interface window
> to be created in a graphics memory unit in response to the
> determination.

The Examiner relies on the following prior art references as evidence
of unpatentability:

| | | |
|---|---|---|
| Bagnas | US 5,805,163 | Sept. 8, 1998 |
| Yanagisawa | US 2001/0020928 | Sept. 13, 2001 |
| Seroussi | US 2003/0005193 | Jan. 2, 2003 |
| Takase | US 6,504,534 | Jan. 7, 2003 |
| Kusanagi | US 6,961,034 | Nov. 1, 2005 |
| | | (filed Jan. 23, 2001) |

Appellants appeal the following rejections:

Claims 24 and 25 stand rejected under 35 U.S.C. § 102(e) as being
anticipated by Takase.

Claim 26 stands rejected under 35 U.S.C. § 103(a) as being

unpatentable over the combination of Takase and Seroussi.

Claims 1, 2, 4, 6, 8-11, and 13-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Takase and Yanagisawa.

Claims 3 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Takase, Yanagisawa, and Seroussi.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Takase, Yanagisawa, and Kusanagi.

Claims 16, 19, and 21-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Bagnas and Yanagisawa.

Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Bagnas, Yanagisawa, and Kusanagi.

## Claims 24 and 25

Appellants contend that Takase fails to disclose "creating an opaque GUI window responsive to a determination that a display unit is off." (App. Br. 7).

Based on Appellants' arguments, we select claim 24 as the representative claim of this group. *See* 37 C.F.R. § 41.37(c)(1)(vii).

## ISSUE

Under § 102, did the Examiner err in determining that Takase discloses:

an opaque window is created in the random access memory unit responsive to a determination that a display unit is to be in an off state, as recited in representative claim 24?

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## FACTUAL FINDINGS (FF)

1.    Appellants' Specification discloses that Fig. 4 is a flow chart of a method that may be performed "when a display unit is turned off (*e.g.*, *immediately before or after* the display unit turns off) according to some embodiments." (Spec. 5, ll. 17-19)(emphasis added).

2.    Takase discloses that in a power save mode the video signal from the host computer is interrupted so that the CRT 10 displays a homogeneous black picture image. (Col. 10, ll. 39-47)

3.    Takase discloses that when the CRT 10 continuously displays the same image for a constant period of time in an operating state of the "screen saver," the video signal from the host computer is interrupted. (Col. 10, ll. 42-45).

4.    Takase discloses that "a power supply control method is provided for a CRT display unit which is adapted to turn off a power circuit after a lapse of a predetermined period of time, as well as, to turn off a heater after a further lapse of a predetermined period of time when a 'screen saver' operates so that a CRT displays a homogeneous black picture image . . . ." (Col. 2, ll. 8-15).

## ANALYSIS

Based upon our review of the record, we find unconvincing Appellants' argument that Takase fails to disclose "creating an opaque GUI window responsive to a determination that a display unit is off." (App. Br. 7).

We note that claim 24 requires that "an opaque GUI window is created in the random access memory unit responsive to a determination that

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a display unit is *to be in an off state*." (emphasis added). We conclude that a
broad but reasonable interpretation of the limitation of determining that "a
display unit is *to be* in an *off state*" (claim 24) does not actually require the
display unit to be off. Thus, we agree with the Examiner (Ans. 13) that the
time period in which the display unit is "*to be* in an *off state*" (as claimed)
includes, in light of Appellants' Specification (FF 1), a period *immediately*
*before* the display unit is actually off. We further agree with the Examiner's
construction that that "off" broadly but reasonably reads on a state of
inactivity. (Ans. 13).

    In light of the above construction, we find that Takase discloses
creating an opaque window (black picture image) in a graphics memory. (FF
2). We further find that Takase discloses creating the black picture image
(opaque window) in response to a determination that the display unit is to be
off (i.e., in a period of inactivity). (FF 3-4).

    Therefore, we find the Examiner did not err in determining that
Takase discloses "an opaque window is created in the random access
memory unit responsive to a determination that a display unit is *to be* in an
off state," as recited in representative claim 24. (emphasis added).
Accordingly, we affirm the Examiner's § 102 rejection of independent claim
24 and claim 25 which falls therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii).


                              Claim 26

    Appellants recite the limitations of dependent claim 26. (App. Br. 8).
We note that a statement which merely points out what a claim recites will
not be considered an argument for separate patentability of the claim. *See*
37 C.F.R. § 41.37(c)(1)(vii). Appellants also contend that Seroussi does not

cure the deficiencies of Takase. (*Id.*). However, we find no deficiencies in Takase for the reasons discussed *supra* regarding independent claim 24. Therefore, we affirm the Examiner's rejection of claim 26 for the same reasons discussed above regarding claim 24.

### Claims 1, 2, 4, 6, 8-11, and 13-15

Appellants note that clam 1 recites "'determining that a display unit has transitioned from a higher power state to a power off state.' Moreover, it is arranged 'for an opaque graphical user interface window to be created in a graphics memory unit <u>in response</u> to the determination.'" (App. Br. 8). Appellants further contend that the Examiner has engaged in impermissible hindsight reconstruction. (App. Br. 9).

Based on Appellants' arguments, we select claim 1 as the representative claim of this group. *See* 37 C.F.R. § 41.37(c)(1)(vii).

### ISSUES

1)    Under §103, did the Examiner err in determining that the cited references would have taught or suggested arranging for an opaque graphical user interface window to be created in a graphics memory unit in response to the determination, as recited in representative claim 1?

2)    Under §103, did the Examiner err by improperly combining the Takase and Yanagisawa references?

FACTUAL FINDINGS (FF)

With respect to the limitations at issue, we adopt the Examiner's findings in the Answer and Final Office Action as our own. (Ans. 6, 14; Final Rejection 4).

ANALYSIS

Issue 1

Based upon our review of the record, we find Appellants' contention unpersuasive that the cited references do not teach or suggest arranging for an opaque graphical user interface window to be created in a graphics memory unit in response to the determination that a display unit has transitioned from a higher power state to a power off state. (App. Br. 8; *see also* claim 1).

We note that the language of claim 1 recites "*arranging for* an opaque graphical user interface *to be* created. . ." (emphasis added). Thus, the opaque GUI window is not positively recited as <u>actually</u> being created in a graphics memory unit. We note that "[a]n intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates." *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003). Although "[s]uch statements often . . . appear in the claim's preamble," *In re Stencel*, 828 F.2d 751, 754 (Fed. Cir. 1987), a statement of intended use or purpose can appear elsewhere in a claim. *Id.*

This reasoning is applicable here. Therefore, we conclude that the recited language of claim 1 ("arranging for . . . to be created") is a statement of intended purpose and is not given patentable weight. On this record, we find Appellants have not shown the Examiner erred in reaching the legal

conclusion of obviousness regarding the disputed limitations of
representative claim 1.


<div align="center">Issue 2</div>

We next decide the question whether the Examiner erred by
improperly combining the Takase and Yanagisawa references.

In particular, Appellants contend that the Examiner has engaged in
impermissible hindsight reconstruction. (App. Br. 9). While we are fully
aware that hindsight bias often plagues determinations of obviousness,
*Graham v. John Deere Co.,* 383 U.S. 1, 36 (1966), we are also mindful that
the Supreme Court has clearly indicated that "[t]he combination of familiar
elements according to known methods is likely to be obvious when it does
no more than yield predictable results," *KSR Int'l Co. v. Teleflex Inc.,* 550
U.S. 398, 416 (2007).

Here, Appellants have failed to demonstrate that the Examiner's
proffered combination of the familiar elements in Takase and Yanagisawa
would have yielded anything more than what one of ordinary skill in the art
would have expected from such a combination. "[W]hen a patent 'simply
arranges old elements with each performing the same function it had been
known to perform' and yields no more than one would expect from such an
arrangement, the combination is obvious." *KSR,* 550 U.S. at 417 (citing
*Sakraida v. AG Pro, Inc.,* 425 U.S. 273, 282 (1976))

This reasoning is applicable here. For the aforementioned reasons, we
affirm the Examiner's § 103 rejection of representative claim 1, and claims
2, 4, 6, 8-11, and 13-15, which fall therewith. *See* 37 C.F.R.
§ 41.37(c)(1)(vii).

Claims 3 and 12

Based on Appellants' arguments, we select claim 3 as the representative claim of this group. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellants recite the limitations of dependent claim 3. (App. Br. 10). We again note that a statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. *See* 37 C.F.R. § 41.37(c)(1)(vii). Appellants also contend that Seroussi does not cure the deficiencies of Takase. (*Id.*). However, we find no deficiencies in Takase for the reasons discussed *supra* regarding independent claim 24. Therefore, we affirm the Examiner's rejection of claim 3 and claim 12 which falls therewith for the same reasons discussed above regarding independent claims 1 and 24. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Claim 5

Appellants acknowledge that Kusanagi teaches that a user may power off an LCD display. (App. Br. 10). Thus, we find that this admitted teaching clearly meets the recited limitation of claim 5: "receiving from a user a request to turn off the display unit." However, Appellants further contend that they do not understand why one of ordinary skill in the art would have combined the references to provide the user with the ability to control the display of opaque window (black window). (*Id.*).

ISSUE

(1)     Under §103, did the Examiner err in combining Takase, Yanagisawa, and Kusanagi?

### FACTUAL FINDINGS (FF)

We adopt the Examiner's findings in the Answer and Final Office Action, with respect to the limitations at issue, as our own. (Ans. 9-10, 16; Final Rejection 7-8).

### ANALYSIS

### ISSUE

We decide the question whether the Examiner erred in combining Takase, Yanagisawa, and Kusanagi.

We note that Appellants have acknowledged that Kusanagi teaches that a user may power off an LCD display. (App. Br. 10). We find powering off a display is clearly a familiar practice known to any computer user – moreover, turning off a display clearly has a predictable result. As stated above, "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results," *KSR*, 550 U.S. at 416. Therefore, we find Appellants' arguments unavailing regarding the Examiner's proffered combination of Takase, Yanagisawa, and Kusanagi. We affirm the Examiner's rejection of claim 5.


### Claims 16, 19, and 21-23

Based on Appellants' arguments, we select claim 16 as the representative claim of this group. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellants contend that the cited references fail to teach or suggest determining that a display unit is powered off and in response to the transition, arranging for a third window (opaque) of the operating system (OS) to be automatically created. (App. Br. 11)

## ISSUE

Under §103, did the Examiner err in determining that the cited references would have taught or suggested arranging for a third window of the OS to be automatically created in response to a display unit transitioning from a power on state to a power off state?

## FACTUAL FINDINGS (FF)

With respect to the limitations at issue, we adopt the Examiner's findings in the Answer and Final Office Action as our own. (Ans. 10-11, 17-18; Final Rejection 8-9).

## ANALYSIS

Similar to our discussion above regarding claim 1, we conclude that the recited limitation of "arranging for . . . to be automatically created" (claim 16)) is a statement of intended purpose and is not given patentable weight.

*See Boehringer* 320 F.3d at 1345; *Stencel* 828 F.2d at 754. On this record, Appellants have not shown the Examiner erred in reaching the legal conclusion of obviousness regarding the disputed limitations of representative claim 16. Therefore, we affirm the rejection of representative claim 16 and claims 19, and 21-23 which fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii).

### Claim 20

We note that although claim 20 is argued separately, Appellants' arguments are essentially commensurate with those presented for claim 5, discussed *supra,* which we did not find persuasive. (App. Br. 11).

We therefore affirm the rejection of claim 20 for the same reasons as those discussed above for claim 5.

## DECISION

We affirm the Examiner's § 102 rejection of claims 24 and 25.

We affirm the Examiner's § 103 rejections of claims 1-16, 19-23 and 26.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

## ORDER

## <u>AFFIRMED</u>

Erc

Buckley, Maschoff & Talwalkar LLC/
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